

## **REMARKS**

### **I. Introduction**

In the Office Action of November 15, 2004, Claims 5, 8, 14, and 19 were rejected under 35 U.S.C. § 112, second paragraph, for containing elements that lacked antecedent basis. Also, independent Claims 1, 10, and 19 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,101,393 to Alperovich et al. Applicants respectfully request reconsideration and withdrawal of these rejections in view of the amendments and remarks made herein.

### **II. 35 U.S.C. § 112, Second Paragraph, Rejections**

Claims 5, 8, 14, and 19 were rejected under 35 U.S.C. § 112, second paragraph, for containing elements that lacked antecedent basis. Claims 5 and 14 were rejected for using the phrase “the call.” In response to this rejection, Applicants have amended Claim 5 to recite “*a* call” instead of “*the* call.” However, with respect to Claim 14, Applicants respectfully traverse the rejection because Claim 14 does not use the phrase “the call.”<sup>1</sup>

With respect to Claims 8 and 19, Applicants believe a typographical error occurred and that the Examiner was referring to Claims 9 and 18 (not 8 and 19), as Claims 8 and 19 do not recited “the preventing act.” Accordingly, Applicants have amended Claims 9 and 18 to recite “the preventing” instead of “the preventing act.” “Preventing” has antecedent basis in base Claims 1 and 10, respectively.

In view of these amendments and remarks, Applicants respectfully submit that the 35 U.S.C. § 112, second paragraph, rejections have been overcome.

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<sup>1</sup> Claim 14: The invention of Claim 10 further comprising determining if the called party is included in the list.

### **III. 35 U.S.C. § 102(e) Rejections of the Independent Claims**

#### **A. Independent Claim 1**

Applicants respectfully traverse the rejection of independent Claim 1. Claim 1 recites preventing a message delivery service *from being offered to a caller*. Alperovich et al. does not teach this element. In Alperovich et al., an SMS text message is sent from an originating mobile phone to a mobile switching center, which queries an HLR that determines whether the SMS message should be delivered to its destination or should be rejected (col. 4, lines 7-46). In other words, the screening takes place after the originating mobile phone created and sent the message. Because Alperovich et al. screens SMS messages that have already been created and sent by the originating mobile phone, whatever “message delivery service” is being used in Alperovich et al. must have been offered to the originating mobile phone (the asserted “caller”). Accordingly, Alperovich et al. does not teach preventing a message delivery service *from being offered to a caller*, as recited in Claim 1. Therefore, Applicants respectfully request removal of the rejections of Claim 1 and its dependent claims.

#### **B. Independent Claim 10**

In this Amendment, Applicants have amended Claim 10 to recite that the message comprises a voice message recorded during a call from a caller to the called party.<sup>2</sup> This element is not shown in Alperovich et al. Alperovich et al. is directed to short message service (SMS) messages. Col. 1, lines 33-44 makes clear that an SMS message is a “non-speech” text message that a user types in. In view of this amendment to Claim 10, Applicants respectfully submit that independent Claim 10 and its dependent claims are patentable over Alperovich et al.

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<sup>2</sup> New Claims 21 and 22, which depend on Claims 1 and 10, respectively, recite a similar element.

**C. Independent Claim 19**

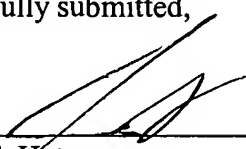
Applicants have amended independent Claim 19 to recite that the software component identifies parties who do not want a message delivery service to be offered to callers. This element is similar to the element in Claim 1 discussed above. As discussed therein, Alperovich et al. screens SMS messages that have already been created and sent through a “message delivery service” offered to a caller. That is, Alperovich et al. merely screens already-created and sent messages — it does not prevent a message delivery service *from being offered to a caller*, as recited in Claim 10. Accordingly, Applicants respectfully request removal of the rejections of Claim 10 and its dependent claim.

**IV. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Reconsideration is respectfully requested. If the Examiner has any questions, he is invited to contact the undersigned attorney at (312) 321-4719.

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Respectfully submitted,

  
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